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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/513,818	02/24/2000	Scott Harvey Demsky	AUS990886USI	7815

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EXAMINER

BROWN, TIMOTHY M

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 05/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/513,818

Applicant(s)

DEMSKY ET AL.

Examiner

Tim Brown

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. This Final Office Action is responsive to Applicants' amendment submitted March 6, 2003 ("Paper No. 8"). Claims 1-7 and 9-13 are pending.

Response to Arguments

Claims 1-3, 5-7, 9, 10 and 13

2. Applicants point out that in Paper No. 4, the Examiner admitted that Ferguson et al. (US 5,966,697) ("Ferguson") fails to teach "having one of the plurality of selectable states indicate that the buyer desires to purchase a desired item from a first merchant if a previous transaction which bought another item from a second merchant can be canceled." Paper No. 8, p. 9. This, Applicants contend, is inconsistent with the current rejection of the claims which holds Ferguson does in fact teach the contested feature.

However, the Examiner notes that during examination, claims must be given their broadest reasonable interpretation consistent with the specification. MPEP § 2111. It is also noted that every claim includes in its breadth or scope, one or more variant embodiments that are not disclosed in the specification, but may nonetheless be anticipated if found in a reference. See MPEP § 904.01(a). Given the policy of taking a broad interpretation of claim language during patent examination, it is not unreasonable for the Examiner to now take a position that is inconsistent with the position taken in Paper No. 4.

Moreover, declaring an examiner's ostensibly inconsistent position an admission is against Office policy. As noted above, the Office encourages examiners to give claims their broadest reasonable interpretation during examination. If an examiner is

strictly held to a position taken in a prior action, the examiner could not possibly give the claims at issue their broadest reasonable interpretation. Therefore, the Examiner submits the inconsistent statement taken in Paper No. 4 should be given only limited weight.

3. Applicants argue Ferguson does not teach a selectable state that indicates that the buyer desires to purchase an item from a first merchant if a previous committed transaction which bought another item from a second merchant can be cancelled. Paper No. 8, pp. 9-10. Applicants point out this feature distinguishes their invention from Ferguson which discloses a shopping cart that allows selected items to be moved in and out of the shopping cart before the items are purchased. *Id.* at 10.

The Examiner respectfully submits the feature Applicants rely upon for distinguishing their invention from Ferguson has no patentable weight. Structural limitations in a method claim that are not disclosed in the prior art are not given patentable weight unless the structural limitations affect the method in a manipulative sense. See *Ex parte Pfeiffer* 135 USPQ 31, 33 (BdPatApp&Int 1961). In the present case, Applicants argue Ferguson lacks a selectable state that indicates the buyer would like to buy an item if an already-completed transaction can be canceled. However, as noted by Applicants, Ferguson discloses a shopping cart that allows items to be added and removed as the user shops. Thus, adding and removing items based upon a user's ability to cancel a previous transaction does not change Ferguson's method in a manipulative sense; items are still being added and removed from a shopping cart based upon the user's subjective desire to purchase the items.

Moreover, whether the selectable state indicates that a buyer desires to purchase an item *if a previous committed transaction can be canceled* is entirely up to the user. For example, prior to implementing Ferguson's online shopping method, a user may have purchased a bottle "White Diamonds" by Elizabeth Taylor (see Ferguson, Fig. 9D) wherein the purchase transaction provided the unconditional return of the item. It is then plausible that a user implementing Ferguson's method could find the same bottle of "White Diamonds" from an online vendor for a lower price. Thus, if the user were to indicate an intent to purchase a bottle of "White Diamonds" from the online vendor, she would be indicating a willingness to enter a transaction based on the ability to cancel the previous transaction. Consequently, defining the selectable state by whether a previous transaction can be cancelled is a subjective limitation that fails to carry patentable weight.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). Claims 1-3, 9, 10 recite a selectable state that indicates a buyer desires to purchase an item if a "previously committed transaction which bought another item from the second merchant can be canceled." However, the ordinary meaning of the term "committed" is to be 'obligated or bound.' See Merriam Webster's Collegiate Dictionary, Tenth Ed. (1999) p. 231. Thus, by providing that a

committed transaction can be canceled, claims 1-3, 9, 10 use the "committed" in a way that is repugnant to its usual meaning.

Claim Rejections - 35 USC § 102

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1-3, 5-7, 9, 10, 12 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Ferguson et al. (US 5,966,697).

Regarding claim 1, Ferguson et al. teach a method for carrying out, over a communication network of interconnecting computers, electronic transactions between a plurality of merchants using at least one server computer and at least one buyer using a client computer, comprising:

displaying, at the client computer, a separate representation for each item selected by the buyer from at least two different merchants wherein each separate representation has an associated one of a plurality of selectable states, and wherein a certain one of the plurality of selectable states indicates that the buyer desires to purchase an item from a first merchant if a previous committed transaction which bought another item from a second merchant can be canceled (col. 2, lines 32-41; col. 8, lines 29-34; col. 9, lines 42-46; col. 13, lines 60-67; and Figs. 9A and 9F); and

displaying an indication of the one associated selectable state with each displayed separate representation (col. 2, lines 32-41; col. 8, lines 29-34; col. 9, lines 42-46; col. 13, lines 28-38 and 60-67; and Figs. 9A and 9F); and

selecting one of the displayed separate representations to have a selectable associated state that indicates that the buyer desires to purchase a desired item from a first merchant if a previous transaction which bought another item from a second merchant can be cancelled (Id.).

Regarding claim 2, Ferguson et al. teach a method for carrying out, over a communication network of interconnecting computers, electronic transactions between a plurality of merchants using at least one server computer and at least one buyer using a client computer, comprising:

enabling the client computer to display a separate representation for each item selected by the buyer from at least two different merchants wherein each representation has one of a plurality of associated states at a given instance in time (col. 2, lines 32-36; col. 8, lines 29-34; col. 13, lines 60-67; and Figs. 9A and 9F); and

displaying an indication of the one associated selectable state with each displayed separate representation (col. 2, lines 32-41; col. 8, lines 29-34; col. 9, lines 42-46; col. 13, lines 28-38 and 60-67; and Figs. 9A and 9F); and

selecting, by the buyer, one of the displayed separate representations to have a selectable associated state that indicates that the buyer desires to purchase the desired item if a previous committed transaction which bought another item from another merchant can be canceled (col. 2, lines 22-26; and col. 8, lines 1-21).

Regarding claim 3, Ferguson et al. teach sending, from the client, to the certain merchant an identification of the other merchant and the other item, and receiving a

notification that the previous committed transaction with the other merchant is canceled (col. 2, lines 31-41).

Regarding claim 5, Fegerson et al. teach changing the selected state to a different state, upon notification of the cancellation, wherein the different state provides an indication of one of the following: a) the buyer desires to put the desired item on hold for a time to consider buying the desired item, and b) the buyer has bought the desired item (col. 11, lines 30-34).

Regarding claim 6, Ferguson et al. inherently teach providing the other item with another representation wherein the associated state is changed, upon receipt of the notification, to indicate that the previous transaction is canceled. Ferguson et al. disclose that a user's order is displayed both before and after a user has deleted unwanted items from the order list (col. 9, lines 42-46; and col. 10, lines 1-13). Therefore, the cancellation of a previously ordered item is indicated by its absence in the modified order list. As a result, Ferguson et al. inherently teach providing the other item with an other representation wherein the associated state is changed, upon receipt of the notification, to indicate that the previous transaction is canceled.

Regarding claim 7, Ferguson et al. teach providing the other item with a displayed other representation on the client computer which becomes automatically deleted, upon receipt of the notification indicating that the previous transaction is canceled (col. 9, lines 42-46; and col. 10, lines 1-13).

Regarding claim 9, Ferguson et al. teach a client computer system enabled to communicate over a network with at least one server computer system for carrying out

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electronic transactions for a buyer using the client computer system for the purchase of items from a plurality of merchants using the at least one server computer system, the client computer system comprising:

a storage device having a set of instructions (Fig. 2; col. 2, lines 32-41; col. 8, lines 29-43; col. 9, lines 42-46; col. 10, lines 1-27; and col. 13, lines 29-39);

a processing unit, connected to the storage device, wherein the processing unit executes the set of instructions for

i. displaying a separate representation for each item selected by the buyer from at least two different merchants wherein each separate representation has an associated one of a plurality of selectable associated states at a given instance in time and wherein a certain one of the plurality of selectable associated states indicates that the buyer desires to purchase an item from a first merchant if a previous committed transaction which bought another item from a second merchant can be canceled;

ii. displaying an indication of the one associated selectable state with each displayed separate representation; and

iii. executing a selection, by the buyer, of a desired item from a certain merchant causing one of the displayed separate representations to have a selectable associated state that indicates the buyer desires to purchase the desired item if a previously committed transaction which bought another item from another merchant can be canceled (Fig. 2; col. 2, lines 32-41; col. 8, lines 29-43; col. 9, lines 42-46; col. 10, lines 1-27; and col. 13, lines 29-39).

Regarding claim 10, Ferguson et al. teach a means for sending, from the client computer, to the certain merchant an identification of the other merchant and the other item, and means for receiving a notification that the previous committed transaction with the other merchant is canceled (col. 2, lines 31-41).

Regarding claim 12, Ferguson et al. teach a means for changing the selected state to a different state, upon notification of the cancellation, wherein the different state provides an indication of one of the following: a) the buyer desires to put the desired item on hold for a time to consider buying the desired item, and b) the buyer has bought the desired item (col. 11, lines 30-34).

Claim 13 is rejected as discussed under claim 1 above as claim 13 pertains to a computer program for accomplishing the method of claim 1.

Claim Rejections - 35 USC § 103

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. **Claims 4 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferguson et al. (US 5,966,697) in view of Walker et al. (US 6,249,772) (Walker '772).**

Regarding claim 4, Ferguson et al. and Walker et al. teach all the limitations discussed under claim 1 above. Ferguson et al. and Walker et al. do not specifically teach a method for carrying out electronic transactions between a plurality of merchants and at least one buyer wherein the selected associated state causes an indication to be sent from the client to the certain merchant to lock specific data associated with the

desired item from being accessible by a different client during a period that the representation for the desired item has the selected associated state. However, Walker '772 discloses reserving an item at a local store after a user has negotiated a price for the item over a communication network (col. 10, lines 35-64). At the time of the applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify Ferguson et al. and Walker et al. to include the teachings of Walker '772 because a method for carrying out electronic transactions between a plurality of merchants and at least one buyer wherein the selected associated state causes an indication to be sent from the client to the certain merchant to lock specific data associated with the desired item from being accessible by a different client during a period that the representation for the desired item has the selected associated state would enable a merchant to hold an item for a buyer so that the item will not be sold while the buyer decides whether to purchase the item.

Claim 11 is rejected as discussed under claim 4 above as claim 11 pertains to a system for accomplishing the method of claim 4.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

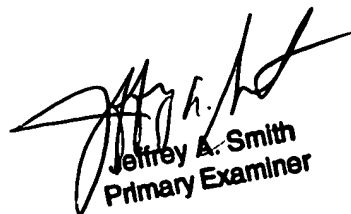
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tim Brown whose telephone number is (703) 305-1912. The examiner can normally be reached on Monday - Friday, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (703) 308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Tim Brown
Examiner
Art Unit 3625

TB
May 19, 2003



Jeffrey A. Smith
Primary Examiner